

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 011348-0021-999

Group Art Unit:	3724	)	
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Examiner:	Hwei Siu Chou PAYER	)	
		)	
Inventor:	Spiros GRATSIAS, <i>et al.</i>	)	
		)	<b>PRE-APPEAL BRIEF</b>
Application No.:	10/596,304	)	<b>CONFERENCE REQUEST</b>
		)	
Filed:	June 8, 2006	)	
		)	
For:	IMPROVED PROCESS FOR THE	)	
	MAKING OF A WET SHAVING	)	
	SYSTEM WITH A GUARD BAR	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the Office Action mailed March 28, 2011 (the "Office Action") in the above-captioned application prior to filing an Appeal Brief. For the reasons set forth below, Applicants respectfully submit that the Office Action fails to establish a *prima facie* rejection of pending claims 14-35. A Notice of Appeal is filed concurrently herewith.

## **I. PROSECUTION SUMMARY**

Independent claims 14, 20, and 27 and dependent claims 15-19, 26, 32, and 33, which depend from claim 14, dependent claims 21-25, 34, and 35, which depend from claim 20, and dependent claims 28-31, which depend from claim 27, have been twice rejected and are pending in the application. Claims 14-35 stand rejected under 35 U.S.C. § 103(a) (hereinafter, "Section 103(a)") as allegedly being unpatentable over U.S. Patent No. 4,998,347 to Schächter (hereinafter, "Schächter '347") in view of U.S. Patent No. 6,167,625 to King, *et al.* (hereinafter, "King") and U.S. Patent Application Publication No. 2003/0208907 to Brown, Jr., *et al.* (hereinafter, "Brown"); claims 14, 20, 26, and 33-35 stand rejected under Section 103(a) as allegedly being unpatentable over Brown; and claims 15-19, 21-25, and 27-32 stand rejected under Section 103(a) as allegedly being unpatentable over Brown in view of Schächter '347.

## **II. FAILURE TO ESTABLISH OBVIOUSNESS UNDER 35 U.S.C. § 103(A)**

### **A. The Rejection of Claims 14-35**

Claim 14 is directed to a process for the manufacture of a wet shaving system comprising the steps of "providing a guard bar having a longitudinal body having two ends, wherein the guard bar is parallel to the blade cutting edge along its entire length; positioning said guard bar in a mold cavity for

said platform; and molding at least part of the platform by injecting plastic in the mold cavity, wherein said at least part of the platform is molded over said ends of said guard bar during the process of molding the platform.” Initially, it should be pointed out that Schächter ’347 does not relate to or disclose a method of manufacturing a shaving head.

In the Office Action, the Examiner asserts that the Schächter ’347 patent “shows a shaving system (10) . . . substantially as claimed except . . . Schächter does not explicitly mention how the guard bar (12) is assembled onto the platform (16).” (Office Action, ¶ 2.) Applicants respectfully disagree and submit that the Schächter ’347 patent does describe and show how the guard bar (12) is assembled onto the platform (16).

As the Schächter ’347 patent states: “The invention disclosed in this application is an improvement upon the inventor’s prior U.S. Pat. No. 4,502,217, the disclosure of which is expressly incorporated herein by reference thereto specifically with regard to the position of the shaving head upon the shaving instrument, *as well as to the attachment of the guard bar to the shaving head.*”<sup>1</sup> (Schächter ’347, col. 3, lines 21-26). United States Patent No. 4,502,217 to Schächter (hereinafter, “Schächter ’217”), discloses, “[t]he guard bar 6 has at its ends legs 10 which form an angle with the guard bar 6 and are inserted into recesses of the base part [1] and are maintained in fixed position in these recesses without play.” (Schächter ’217, col. 2, lines 20-24) These features are shown, for example, in Figures 2, 3 and 9 from the Schächter ’217 patent. Thus, a person of skill in the art reading the Schächter ’347 patent would look to the Schächter ’217 patent in order to determine how the guard bar (12) in the Schächter ’347 patent is attached onto the platform (16).

As disclosed in Schächter ’217, “[a]nother comfort in handling resides in that the opening between the guard bar and the blade permits the unimpaired passage of cut hairs and soap because lugs or stops keep[ ] the guard bar *spaced away* [from the blade].” (Schächter ’217, col. 1, lines 49-52.) Schächter ’217 also discloses: “The front side of the base part 1 and the cover 3 form a front face 7 . . . For exactly maintaining the *distance* of the guard bar 6 from the front face 7, lugs 1a are provided at the base part 1 in close proximity to the legs.” (*Id.* at col. 2, lines 24-27.) The lugs 1a can be seen in Figure 9 from the Schächter ’217 patent. Thus, the Schächter ’217 patent discloses that a space must be maintained between the guard bar 6 and the front face 7 of the base part 1 and cover 3 in order to maintain comfort in shaving.

In the Office Action, the Examiner asserts that (1) Schächter ’347 “shows a shaving system (10) . . . substantially as claimed except the guard bar (12) is not of the claimed type such that it is parallel to the blade cutting edge ‘along its entire surface,’” and (2) that “it is well known in the shaving art to have the guard bar of a wet shaver parallel to the blade cutting edge along its entire length as evidenced by King et al.” (Office Action, ¶ 2.) Thus, the Examiner concludes that “it would

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<sup>1</sup> Emphasis is added throughout unless otherwise indicated.

have been obvious to one skilled in the art at the time this invention was made to modify Schächter by having the guard bar (12) of the type that is parallel to the blade cutting edge along its entire length.” (*Id.*) Applicants respectfully disagree and submit that the Schächter patents teach away from the combination with King to arrive at the claimed guard bar that is parallel to the blade cutting edge along its entire length.

It is well established that if a reference teaches away from an invention, that finding can defeat an obviousness claim grounded on that reference. *See* M.P.E.P. 2145(X)(D)(2) (citing *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983)); *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000). A “reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *Winner Int’l Royalty Corp.*, 202 F.3d at 1349-50. In addition, “[i]t is improper to combine references where the references teach away from their combination.” M.P.E.P. § 2145(X)(D)(2) (citing *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983)).

Thus, because the Schächter ’217 patent teaches that a space must be maintained between the guard bar 6 and the front face 7 of the base part I and cover 3, contrary to the Examiner’s assertion, there is no way to modify the guard bar described in the Schächter ’217 and Schächter ’347 patents such that the guard bar is parallel to the blade cutting edge *along its entire length*. The only way that the Schächter ’217 and Schächter ’347 guard bar can be modified so that it is parallel to the blade cutting edge along its entire length is to completely recess the entire length of the right angle bent end portions 26 of the Schächter ’347 guard bar (*see* Schächter ’347, col. 3, lines 59-64; Fig. 4) within the cover or cover member. However, (1) this cannot be achieved because the lugs 1a prevent the guard bar from being moved in towards the cover any closer than the length of the lugs 1a, and (2) if this could be achieved, doing this will completely eliminate the space that the Schächter ’217 patent teaches is required between the guard bar 6 and the front face 7 of the base part I and cover 3 in order to maintain shaving comfort. Thus, the Schächter ’217 patent and hence, the Schächter ’347 patent, both teach away from a guard bar that is parallel to the blade cutting edge along its entire length.

As discussed above, an important feature of the shaving instrument of the Schächter ’347 and Schächter ’217 patents is that the guard bar is spaced at a distance from the cover or cover member such that there is a gap between the two. As also discussed above, modifying the Schächter guard bar as the Examiner suggests to arrive at the claimed process would eliminate the required space between the guard bar and the cover or cover member, rendering the Schächter shaving instrument unsatisfactory for its intended purpose. Thus, Applicants respectfully submit that there is no motivation to modify the Schächter ’347 patent as suggested by the Examiner. *See* M.P.E.P. 2143.01(V) (“If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification” (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984))). Further, because there is no

suggestion or motivation to make the modification or combine Schächter '347 with King as the Examiner contends, the Examiner is relying on impermissible hindsight and is basing the combination and modification on Applicants' own disclosure. *See* M.P.E.P. 2145(X).

In *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the Supreme Court upheld the principle of *avoiding hindsight bias* and cautioned courts to *guard against reading into the prior art the teachings of the invention in issue*:

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. *See Graham*, 383 U.S. at 36, (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "'guard against slipping into the use of hindsight'" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (C.A.6 1964))).

*See KSR*, 127 S. Ct. at 1742

Thus, Applicants respectfully submit that, contrary to the Examiner's assertion, it would not have been obvious to one skilled in the art to modify the Schächter '347 guard bar in view of the King guard bar to arrive at the claimed guard bar that is "parallel to the blade cutting edge along its entire length." Further, as discussed in detail in Section II(B) below, Applicants respectfully submit that Brown fails to cure the deficiencies of Schächter '347 and King.

For at least the foregoing reasons, it is believed that independent claim 14 is patentable over Schächter '347, King, and Brown, either taken alone or in combination, and is therefore allowable. Independent claims 20 and 27 include similar recitations to those discussed above for claim 14 and are therefore allowable for similar or somewhat similar reasons to those discussed for claim 14. Further, claims 15-19, 26, 32 and 33, which depend from claim 14, claims 21-25, 34 and 35, which depend from claim 20, and claims 28-31, which depend from claim 27, are believed to be allowable as well.

**B. The Rejection of Claims 14, 20, 26 and 33-35**

In paragraph 3 of the Office Action, the Examiner alleges that Brown discloses a process for the manufacture of a wet shaving system substantially as claimed except That Brown "do[es] not explicitly mention . . . molding at least part of the platform over the ends of the guard bar (20) during the process of molding the platform (16)." The Examiner further states that Brown "does teach overmolding by positioning a blade (18) in a mold cavity (112) and molding at least part of the platform (16) by injecting plastic in the mold cavity (112), and wherein the at least part of the platform (16) is molded over two end portions of the blade (18)." Thus, the Examiner asserts that "to have at least part of the platform (16) of Brown . . . molded over the ends of the guard bar (20) during the process of molding the platform (16) to facilitate quick and massive production would have been obvious to one skilled in the art." (Office Action, ¶ 3.) Applicants respectfully disagree.

As disclosed at paragraph [0038] of Brown, "[g]uard bar 20 includes a finned unit *molded on the front of housing 16 . . .*" Molding the guard bar (20) on the front of the housing (16) attaches the

guard bar (20) to the housing (16). Thus, there is no motivation for a person of skill in the art to mold part of the platform (16) over the ends of the guard bar (20) to facilitate quick and massive production as the Examiner asserts. In fact, molding the part of the platform (16) over the ends of the guard bar (20) would slow down production because this would be a extra processing step as the guard bar would already be attached to the platform due to it being "molded on the front of housing 16."

For at least the foregoing reasons, it is believed that independent claim 14 is patentable over Brown and is therefore allowable. Independent claim 20 includes similar recitations to those discussed above for claim 14 and is therefore allowable for similar or somewhat similar reasons to those discussed for claim 14. Further, claims 26 and 33, which depend from claim 14, and claims 34 and 35, which depend from claim 20, are believed to be allowable as well.

**C. The Rejection of Claims 15-19, 21-25 and 27-32**

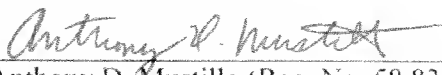
As discussed in Sections II(A) and II(B) above, both Brown and Schächter '347, either alone or in combination, fail to disclose or suggest a process for the manufacture of a wet shaving system comprising, *inter alia*, "providing a guard bar . . . wherein the guard bar is parallel to the blade cutting edge along its entire length . . . and molding at least part of the platform . . . wherein at least part of the platform is molded over the ends of the guard bar during the process of molding the platform," which is recited in claim 27. Accordingly, at least for the reasons discussed above in Sections II(A) and II(B), it is believed that claim 27 is patentable over Brown and Schächter '347. Further, claims 28-31, which depend from claim 27, are believed to be allowable as well.

Claims 15-19, and 32 depend from independent claim 14, which was shown in Sections II(A) and II(B) to be patentable over Brown and Schächter '347, either taken alone or in combination, and claims 21-25 depend from independent claim 20, which was also shown in Sections II(A) and II(B) to be patentable over Brown and Schächter '347, either taken alone or in combination. Accordingly, for at least the foregoing reasons, it is believed that claims 15-19, 21-25, and 32 are patentable over Brown and Schächter '347, either taken alone or in combination, and are therefore allowable.

**III. CONCLUSION**

It is believed that claims 14-35 are in condition for allowance. Accordingly, Applicants respectfully request the issuance of a Notice of Allowance. No fee is believed due for this Pre-Appeal Brief Conference Request. However, should any fee(s) be due at this time, please charge such fee(s) to Jones Day Deposit Acct. No. 50-3013.

Date: June 28, 2011

Respectfully submitted,  
  
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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

011348-0021-999

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Typed or printed  
name \_\_\_\_\_

Application Number

10/596,304

Filed

June 8, 2006

First Named Inventor

Spiros GRATSIAS

Art Unit

3724

Examiner

Hwei Siu Chiu PAYER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

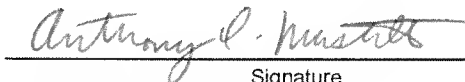
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attorney or agent acting under 37 CFR 1.34.

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June 28, 2011

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required. see below\*.

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